PATENT

Atty Docket No.: 10003477-1
App. Ser. No.: 09/875,833

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the amendments above and the following remarks. Claims 1, 14, 15, and 28 have been amended. Claims 11, 13, and 17-27, 29-35, and 37 have been canceled without prejudice or disclaimer of the subject matters contained therein. Claims 39-41 have been added. Claims 1-10, 12, 14-16, 28, and 36, and 38-41 are pending, of which claims 1, 28, 39, 40, and 41 are independent.

Claims 1-3, 7, 11-14, 17, 28, 36, and 37 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hiramatsu et al. (U.S. Patent Application Publication No. 2002/0085112).

Claims 1-3, 5, 7, 8, 11, 17, and 28 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Niikawa et al. (U.S. Patent Application Publication No. 2001/0043279).

Claims 1, 5 and 11-14 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Teoman et al. (U.S.P. No. 6,463,509) in view of Barrus et al. (U.S. Patent Application Publication No. 2001/0045884).

Claims 4 and 6 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Tsukamoto et al. (U.S. Patent Application Publication No. 2002/0048033) in view of Sarkozy et al. (U.S.P. No. 5,893,919) and further in view of Shimotono et al. (U.S.P. No. 5,797,022).

Claims 15, 16, and 38 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Niikawa in view of Levy (U.S.P. No. 5,438,549).

Claim 9 has been objected as being dependent upon a rejected based claim, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

The above claim rejections are respectfully traversed.

Information Disclosure Statement

The undersigned thanks the Examiner for considering the reference cited in the IDS filed on May 26, 2005.

Office Interview on August 11, 2005

The undersigned thanks the Examiner for the Office Interview held on August 11, 2005, wherein the references Hiramatsu et al., Niikawa et al., Teoman et al., and Barrus et al. were discussed. The undersigned appreciates the Examiner's indication during the interview that he will further review the discussed references in light of arguments presented during the interview and repeated below.

Objection to claim 9 (and therefore new claim 39)

The objection of claim 9 indicating that it includes allowable subject matter is noted with appreciation. Accordingly, as suggested by the Final Office Action, claim 39 has been added, wherein claim 39 is the objected claim 9 that has been rewritten in independent form to include all limitations of the previously-presented base claim 1 and previously-presented intervening claims 2, 3, and 7.

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Claim Rejections under 35 U.S.C. § 102(e)

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-3, 7, 11-14, 17, 28, 36, and 37 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hiramatsu et al.

Claims 13 and 37 (now amended claims 1 and 28)

The Final Office Action has rejected claims 13 and 37 as allegedly being anticipated by Hiramatsu et al. Claim 13 recited, *inter alia*, a transfer of data from the temporary data storage circuit to the permanent data storage circuit upon an occurrence of "further data being received by the temporary data storage circuit from the data generating appliance." Similarly, claim 37 recited, *inter alia*, "transferring said image data from said temporary data storage circuit to said permanent data storage circuit upon obtaining said further image data."

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The Final Office Action has rejected claims 13 and 37 because Hiramatsu et al. allegedly show a data transfer "every time a picture is taken." Final Office Action, p. 3, paragraph 5. It is respectfully submitted that while Hiramatsu et al. may show a data transfer every time a picture is taken, such data transfer is not conditional on an occurrence of further data being received by the temporary data storage circuit as claimed. This is evident from the various timing charts shown in Hiramatsu et al. For example, FIGs. 2, 3, 4, and 9 of Hiramatsu et al. all show read-out modes for data transfer that are in effect only when the camera shutter is closed. Thus, the image pickup element 2, which the Final Office Action alleges as the temporary data storage circuit, could not possibly receive further data, a condition that prompts the data transfer as previously claimed in claims 13 and 37, when the camera shutter is closed. On the hand, FIGs. 11, 12, 15, and 17 of Hiramatsu et al. show read-out modes for data transfer that are in effect at constant time intervals, regardless whether the camera shutter is opened (for receiving new data into element 2) or closed (for receiving no additional data into element 2). Therefore, because read-out modes of Hiramatsu et al. occur at constant intervals and independent of whether further data is received by the element 2, Hiramatsu et al. cannot be said to disclose a data transfer *upon* further data being received or obtained by the temporary data storage circuit, as recited in claims 13 an 37.

Accordingly, it is respectfully submitted that Hiramatsu et al. fail to anticipate each and every element of claims 13 and 37. To expedite the prosecution of the present application, claim 1 has been amended to incorporate those features recited in claim 13 and intervening claim 11, and claims 11 and 13 have been canceled. Likewise, claim 28 has been amended to incorporate those features recited in claim 37, which also has been canceled.

Thus, it follows that Hiramatsu et al. fail to anticipate each and every element of newly amended claims 1 and 28, and these claims and their dependent claims 2-10, 12, 14-16, 29-36, and 38 are allowable over the references of record.

Claim 36 (and therefore new claim 40)

The Final Office Action has rejected claim 36 as being anticipated by Hiramatsu et al. Claim 36 recites an image data transfer after a predetermined time period "if an erase command is not received during the predetermined time period." The Final Office Action has rejected claim 36 by broadly interpreting the conditional features "if an erase command is not received" to mean that an erase command is not involved in the data transfer operation. Consequently, because there is no erase command discussed in Hiramatsu et al., no such erase command is received during the claimed predetermined time period.

It is respectfully submitted that this rejection neglects the features of "monitoring whether an erase command is received" as actively recited in claim 36. In contrast, because Hiramatsu et al. do not disclose any erase command whatsoever, there can be no monitoring of a non-existing erase command in Hiramatsu et al.

Accordingly, it is respectfully submitted that Hiramatsu et al. fail to disclose each and every element of claim 36. Thus, it follows that Hiramatsu et al. also fail to disclose each and every element of claim 40, which is previously-presented claim 36 rewritten in independent form to include all limitations of the previously-presented base claim 28.

Claims 1-3, 5, 7, 8, 11, 17, and 28 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Niikawa et al.

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Claim 8 (and therefore new claim 41)

The Final Office Action has rejected claim 8 as being anticipated by Niikawa et al. allegedly showing temporary data storage circuit 209, 210, 220 that comprise RAM as claimed. As stated in paragraphs [0080] and [0081] of Niikawa et al., memories 210 and 220 are indeed VRAMs. However, VRAMs 210 and 220 are merely buffer memory for storing image data to be displayed on the LCD and EVF of the camera. Thus, in contrast to claim 1, on which claim 8 depends, there is no data transfer from VRAMs 210 and 220 to a permanent data storage circuit in Niikawa et al. Consequently, it is respectfully submitted that, at best, only memory 209 should be considered a part of a temporary data storage circuit as claimed. However, in contrast to claim 8, Niikawa et al. do not specify memory 209 as a RAM. In fact, paragraph [0079] of Niikawa et al. teaches away from memory 209 being a RAM. As stated in paragraph [0079] the image memory 209 has a storage capacity of only one frame, which can then be transferred to the memory card 8. Thus, there is no need for the image memory 209 to be a RAM (random access memory) because there is no need to randomly access the memory 209 when the entire data load of the memory 209 will be transferred to the memory card 8 anyway.

Accordingly, it is respectfully submitted that Niikawa et al. fail to disclose each and every element of claim 8. Thus, if follows that Niikawa et al. also fail to disclose each and every element of new claim 41, which is previously-presented claim 8 rewritten in independent form to include all limitations of the previously-presented base claim 1 and previously-presented intervening claims 2, 3, and 7.

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Claim Rejections under 35 U.S.C. § 103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1, 5 and 11-14 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Teoman et al. in view of Barrus et al.

Claim 13 (now amended claim 1)

The Final Office Action has rejected claim 13 as being unpatentable over Teoman et al. in view of Barrus et al. Claim 13 recited, *inter alia*, a temporary data storage circuit having a "storage capacity sufficient to store data comprises at least one picture" from the portable data generating appliance (see claim 1). In contrast, Teoman et al. merely show an apparatus and method for caching data in a storage device of a computer system, and Barrus et al. merely show a portable computer that supports paging functions. Thus, neither Teoman

et al. nor Barrus et al. show any temporary data storage circuit that stores data comprising at least one *picture* from a portable data generating appliance as claimed.

As discussed earlier, claim 13 also recited, *inter alia*, a transfer of data from the temporary data storage circuit to the permanent data storage circuit upon an occurrence of "further data being received by the temporary data storage circuit from the data generating appliance." The Final office action has cited "figure 16, step 384" and col. 13, lines 10-12 of Teoman et al. to reject the aforementioned claimed features. However, it is respectfully submitted that there is no figure 16 in Teoman et al. (or Barrus et al.). Indeed, Teoman et al. provide only 12 figures, and Barrus et al. provide only 4 figures. Furthermore, col. 13, lines 10-12 of Teoman et al. discuss writes to regions of physical storage are deferred until a triggering event is detected, "such as passage of a predetermined period of time, system idle, receipt of a threshold number of I/O requests, receipt of a write back request from the operating system or user cache manager." Thus, in contrast to claim 13, there is no specific discussion of further data being received as a triggering event in Teoman et al. As for Barrus et al., there is no column 13.

Accordingly, it is respectfully submitted that the Final Office Action fails to establish a prima facie case of obviousness against claim 13, which is now amended claim 1, based on Teoman et al. and Barrus et al.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application for the pending claims are earnestly solicited.

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Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: September 19, 2005 By

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